

## **REMARKS**

Claims 2-5, 24-41 and 51-61 remain pending.

### **Claim Rejections – 35 USC § 112**

Claim 2-5, 24 and 51-58 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. These claims have been amended to remove the terms “substantially unrestricted”, “substantially equivalent”, “without substantial restriction” and “without substantial flow restriction.”

Claim 2-5, 24 and 51-58 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The relevant claims have been amended to remove the terms “substantially unrestricted”, “substantially equivalent”, “without substantial restriction” and “without substantial flow restriction.” Regarding claim 58, the term “normal operational parameters” has been removed.

### **Claim Rejections – 35 USC § 102**

Claims 3-5 and 51 – 55 were rejected under 35 USC 102(e) as being anticipated by Chen 5,337,708.

Pursuant to 37 C.F.R. §1.131, the applicant submits with this Response a declaration establishing invention of the subject matter of the rejected claim prior to the effective date of the reference.

The declaration and attached Exhibits 1 – 4 together establish reduction to practice prior to the effective date of the reference. Photocopies of original exhibits of construction and records are provided within Exhibits 1 – 4.

Additionally, it is submitted that Chen ‘708 is not prior art under 35 USC 102 as new claim 59 is directed to a method found first in earlier U.S. Patent application 07/781,322 which matured into U.S. Patent 5,318,080 and throughout the later continuation applications.

Claim 59 recites a method of recirculating fluid and exchanging fresh fluid for used fluid within the automatic transmission and cooling circuit. US Patent 5,318,080 recites such a method wherein accessory conduit 55 is interposed into the cooling circuit and the vehicle is operated to recirculate used fluid within the accessory conduit during which time the operator is able to determine fluid flow direction via sight glasses 46, 51 and pressure gauge 56. Fluid communication between the accessory conduit 55 and the cooling circuit is subsequently disconnected and the first and second conduits of the exchange system are provided in fluid communication with the cooling circuit and automatic transmission so that used fluid from the cooling circuit is received into the first conduit and fresh fluid is received into the second conduit and introduced into the cooling circuit. As a result, it is submitted that the effective filing date of the present application is October 23, 1991, based on U.S. Patent 5,318,080.

Reconsideration of the rejection based on Chen '708 is respectfully requested.

Claims 51-52 were also rejected under 35 USC 102(b) as being anticipated by Japanese Patent 2-72,299. It is submitted that Japanese Patent 2-72,299 does not disclose a first operational condition wherein used fluid is passed through the bypass fluid line and reintroduced into the cooling circuit without flow restriction. Applicant respectfully disagrees with the statement that used fluid is passed through the bypass conduit and reintroduced into the cooling circuit "without substantial flow restriction" (P.10, lines 19-20). To the contrary, and as more fully explained below, flow through bypass conduit 11 is substantially restricted and an unequal pressure exists on either side of pressure responsive valve 12.

It is submitted that Japanese Patent 2-72,299 does not teach or suggest a fluid exchange system having a bypass feature according to the claims 51 and 52 of the present invention, i.e., a bypass conduit which permits fluid from the vehicle to be recirculated back to the vehicle without flow restriction. Bypass conduit 11 of 2-72,299 has a pressure responsive valve which provides selective communication only at high pressure conditions. The valve only opens when the inflow pressure reaches a higher than ordinary pressure, such as when valve 6 closes. Operating as a pressure relief device, flow through conduit 11 would occur only when the pressure is substantially greater than the ordinary operating pressure of the vehicle. In other

words, when the valve is opened a significant pressure differential would exist across conduits of the exchange system. In comparison, the bypass conduit of the present invention is without restriction from a pressure responsive valve.

### **Claim Rejections – 35 USC § 103**

Claims 2, 24, 26 and 31-33 were rejected under 35 USC 103(a) as being unpatentable over Chen '708 in view of Becnel '941. In view of the declaration establishing invention of the subject matter of the rejected claim prior to the effective date of Chen '708, it is submitted that Chen '708 is not prior art and therefore this rejection is improper. Additionally, it is submitted that the effective filing date of the present application is October 23, 1991, based on U.S. Patent 5,318,080. Reconsideration of the rejected claims is requested.

Claim 33 was rejected under 35 USC 103(a) as being unpatentable over Chen '708 and Becnel '941 as applied to claim 32 above. In view of the declaration establishing invention of the subject matter of the rejected claim prior to the effective date of Chen '708, it is submitted that Chen '708 is not prior art and therefore this rejection is improper. Reconsideration of the rejected claims is requested.

Claims 24, 26, 32 and 56-58 were rejected under 35 USC 103(a) as being unpatentable over Japanese 2-72,299 in view of Becnel. It is submitted that the combination of these references would fail to yield an exchange system having an unrestricted bypass conduit as provided by the applicant's system. It is submitted that Japanese Patent 2-72,299 does not teach or suggest a fluid exchange system having a bypass feature according to the present invention, i.e., a bypass conduit which permits fluid from the vehicle to be recirculated back to the vehicle with minimal pressure increase. Bypass conduit 11 of 2-72,299 has a pressure responsive valve which provides selective communication only at high pressure conditions. The valve only opens when the inflow pressure reaches a higher than ordinary pressure, such as when valve 6 closes. Operating as a pressure relief device, flow through conduit 11 would occur only when the pressure is substantially greater than the ordinary operating pressure of the vehicle. In other words, when the valve is opened a significant pressure differential would exist across conduits of the exchange system. In comparison, the bypass conduit of the present invention is unrestricted.

Claim 33 was rejected under 35 USC 103(a) as being unpatentable over Japanese 2-72,299 in view of Becnel. It is submitted that the combination of these references would fail to yield an exchange system having an unrestricted bypass conduit as provided by the applicant's system.

Claims 24, 26, 32, and 56-58 were rejected under 35 USC 103(a) as being unpatentable over Japanese Patent 2,72-299 in view of Becnel '941. It is submitted that the combination of these references would fail to yield an exchange system having an unrestricted bypass conduit as provided by the applicant's system.

Claim 33 was rejected under 35 USC 103(a) as being unpatentable over Japanese Patent 2,72-299 and Becnel '941. It is submitted that the combination of these references would fail to yield an exchange system having an unrestricted bypass conduit as provided by the applicant's system.

Claims 26 and 31-32 were rejected under 35 USC 103(a) as being unpatentable over Japanese Patent 2,72-299 and Becnel '941 and Parker '060. It is submitted that the combination of these references would fail to yield an exchange system having an unrestricted bypass conduit as provided by the applicant's system.

Claim 33 was rejected under 35 USC 103(a) as being unpatentable over Japanese Patent 2,72-299 and Becnel '941 and Parker '160. It is submitted that the combination of these references would fail to yield an exchange system having an unrestricted bypass conduit as provided by the applicant's system.

Claims 54-55 were rejected under 35 USC 103(a) as being unpatentable over Japanese Patent 2,72-299 in view of either Ohta '315 or Takeuchi '673. It is submitted that the combination of these references would fail to yield an exchange system having an unrestricted bypass conduit as provided by the applicant's system.

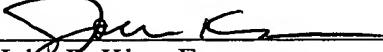
**Request for Reconsideration and Allowance**

Based upon the above Amendments and Remarks, claims 2-5, 24-41 and 51-61 are believed to be in proper form for allowance. Applicant respectfully requests reconsideration of those claims and a prompt Notice of Allowance thereon.

Please direct any questions or comments regarding this application to John F. Klos at (612) 321-2806.

Respectfully submitted,  
James P. Viken, by his attorneys,

Dated: February 27, 2004

By:   
John F. Klos, Esq.  
Registration No. 37, 162  
Fulbright & Jaworski L.L.P.  
80 South Eighth Street, Suite 2100  
Minneapolis, MN 55402  
(612) 321-2806

**CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8:** I hereby certify that this paper and any papers referred to herein are being deposited with the U.S. Postal service, as first class mail, postage prepaid, addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 27, 2004.

John F. Klos:   
Signature